

REMARKS/ARGUMENTS

The claims are amended as set forth above. Applicants respectfully reserve the right to pursue the subject matter of any cancelled claims in any forthcoming continuation application(s). Claim 54-58 are new. Reconsideration of the above claims is respectfully requested in light of the arguments herein.

I. Support for Claim Amendments and New Claims

As support for the claim amendments and new claims, applicants respectfully point Examiner Shirpiro to the specification at page 2, line 26 – page 3, line 3; page 7, line 3 – page 8, line 30.

II. Rejections Under 35 U.S.C. § 103

Claims 45-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0021701 published to Iwema et al. (hereinafter “Iwema”) in view of U.S. Patent No. 5,757,383 issued to Lipton (hereinafter “Lipton”). Applicants respectfully disagree with the rejection. Independent claim 45 includes the following combination of features that is not taught or otherwise suggested by the cited references:

selecting an electronic pen for functioning as an electronic highlighter device;

engaging the electronic pen with a computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection from the engagement, wherein determining the height of the computer-displayed handwritten text selection from the engagement includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection;

after the automatic determination of the height of the computer-displayed handwritten text selection, setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic

pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection; and

after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed handwritten text selection.

The above combination of features is not taught or otherwise suggested by the cited references. With regard to Iwema, Iwema teaches a selection tool that includes graphical handles that may be used to indicate the vertical bounds of the selection ink path and the starting point and end point of the selection ink path. The graphical handles are indicated in Fig. 5 by reference numeral 410. (Iwema at ¶ 0055). In paragraph 0037 of Iwema, Iwema teaches a freeform selection line. (Iwema at ¶ 0037). The encounter selection tool selects graphical objects that are touched by the selection line. As indicated in Fig. 5, as the user uses the selection tool, the ink text that engages the selection is graphically changed. As indicated in paragraphs 0037 and 0055 of Iwema, Iwema teaches that the selection ink path is dictated by what the user sets as the vertical bounds for the graphical handles. In Lipton, Lipton chooses a portion of text to highlight by inserting a base-line. As indicated, the base-line is associated with the orientation of the text input. A dashed shape is then input having a top and bottom line. The top line is offset from the base-line of the geometric path. The bottom line is also offset from the geometric path. The upper and lower lines are then connected to form a geometric shape. (Lipton at Col. 3, lines 50-65). The shape is formed by requesting a graphic system to return the distance that the top line segment is positioned above the base-line. The bottom line is positioned below the base-line which is called the descent. It is also positioned by requesting the graphic system to return such a distance. The ascent and the descent are determined by calling a function called "GXGetLayoutSpan" and are ascents and descents of the highlight itself not of the text. (Lipton at Col. 4, lines 37-47). In further regard to Lipton, Lipton teaches that the present invention is intended to apply to other forms of selection. The example given in Lipton includes a selection method that blocks half the height of the typography rather than the

entire height. Lipton continues with the example by indicating that it should also be understood that the continuous highlighting method and system of the present invention will work for typography formed from languages other than English. (Lipton at Col. 5, lines 27-37). All of the figures within Lipton indicate a highlighting of the words in their entirety. (See Fig. 8). Moreover, Lipton teaches the generation of a shape from the baseline entry. Accordingly, neither reference teaches or otherwise suggests “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection from the engagement, wherein determining the height of the computer-displayed handwritten text selection from the engagement includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.” in combination with “after the automatic determination of the height of the computer-displayed handwritten text selection, setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection” further in combination with “after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed handwritten text selection.” Reconsideration is respectfully requested.

Independent claim 48 includes the following combination of features that is not taught or otherwise suggested by the cited references:

- selecting an electronic pen for functioning as an electronic highlighter device;
- engaging the electronic pen with a computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection *from the engagement*, wherein determining the height of the computer-displayed handwritten text selection *from the engagement* includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection;

after the automatic determination of the height of the computer-displayed handwritten text selection, setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection; and

after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed handwritten text selection.

The above combination of features is not taught or otherwise suggested by the cited references. With regard to Iwema, Iwema teaches a selection tool that includes graphical handles that may be used to indicate the vertical bounds of the selection ink path and the starting point and end point of the selection ink path. The graphical handles are indicated in Fig. 5 by reference numeral 410. (Iwema at ¶ 0055). In paragraph 0037 of Iwema, Iwema teaches a freeform selection line. (Iwema at ¶ 0037). The encounter selection tool selects graphical objects that are touched by the selection line. As indicated in Fig. 5, as the user uses the selection tool, the ink text that engages the selection is graphically changed. As indicated in paragraphs 0037 and 0055 of Iwema, Iwema teaches that the selection ink path is dictated by what the user sets as the vertical bounds for the graphical handles. In Lipton, Lipton chooses a portion of text to highlight by inserting a base-line. As indicated, the base-line is associated with the orientation of the text input. A dashed shape is then input having a top and bottom line. The top line is offset from the base-line of the geometric path. The bottom line is also offset from the geometric path. The upper and lower lines are then connected to form a geometric

shape. (Lipton at Col. 3, lines 50-65). The shape is formed by requesting a graphic system to return the distance that the top line segment is positioned above the base-line. The bottom line is positioned below the base-line which is called the descent. It is also positioned by requesting the graphic system to return such a distance. The ascent and the descent are determined by calling a function called "GXGetLayoutSpan" and are ascents and descents of the highlight itself not of the text. (Lipton at Col. 4, lines 37-47). In further regard to Lipton, Lipton teaches that the present invention is intended to apply to other forms of selection. The example given in Lipton includes a selection method that blocks half the height of the typography rather than the entire height. Lipton continues with the example by indicating that it should also be understood that the continuous highlighting method and system of the present invention will work for typography formed from languages other than English. (Lipton at Col. 5, lines 27-37). All of the figures within Lipton indicate a highlighting of the words in their entirety. (See Fig. 8). Moreover, Lipton teaches the generation of a shape from the baseline entry. Accordingly, neither reference teaches or otherwise suggests "in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection from the engagement, wherein determining the height of the computer-displayed handwritten text selection from the engagement includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection," in combination with "after the automatic determination of the height of the computer-displayed handwritten text selection, setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection" further in combination with "after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the

determined height onto the computer-displayed handwritten text selection.” Reconsideration is respectfully requested.

Independent claim 51 includes the following combination of features that is not taught or otherwise suggested by the cited references:

a processor; and

a memory having computer-executable instructions stored thereon, wherein the computer-executable instruction are configured for:

selecting an electronic pen for functioning as an electronic highlighter device;

engaging the electronic pen with a computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection *from the engagement*, wherein determining the height of the computer-displayed handwritten text selection *from the engagement* includes *determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection;*

after the automatic determination of the height of the computer-displayed handwritten text selection, setting a height of a cursor for inputting electronic highlighter ink to the determined height, wherein the height of the cursor is configured to highlight *the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection;*

after the setting of the height of the cursor to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed handwritten text selection;

after disengaging the highlight input, engaging the electronic pen with a computer-displayed object other than the computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed object, automatically discarding the determined height and determining the height of the computer-displayed object from the engagement;

after the automatic determination of the height of the computer-displayed object, setting the electronic ink height of the electronic pen to the determined height; and

after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed object.

The above combination of features is not taught or otherwise suggested by the cited references. With regard to Iwema, Iwema teaches a selection tool that includes graphical handles that may be used to indicate the vertical bounds of the selection ink path and the starting point and end point of the selection ink path. The graphical handles are indicated in Fig. 5 by reference numeral 410. (Iwema at ¶ 0055). In paragraph 0037 of Iwema, Iwema teaches a freeform selection line. (Iwema at ¶ 0037). The encounter selection tool selects graphical objects that are touched by the selection line. As indicated in Fig. 5, as the user uses the selection tool, the ink text that engages the selection is graphically changed. As indicated in paragraphs 0037 and 0055 of Iwema, Iwema teaches that the selection ink path is dictated by what the user sets as the vertical bounds for the graphical handles. In Lipton, Lipton chooses a portion of text to highlight by *inserting a base-line*. As indicated, the base-line is associated with the orientation of the text input. A dashed shape is then input having a top and bottom line. The top line is offset from the base-line of the geometric path. The bottom line is also offset from the geometric path. The upper and lower lines are then connected to form a geometric shape. (Lipton at Col. 3, lines 50-65). The shape is formed by requesting a graphic system to return the distance *that the top line segment is positioned above the base-line*. The bottom line is positioned below the base-line which is called the descent. It is also positioned by requesting the graphic system to return such a distance. The ascent and the descent are determined by calling a function called "GXGetLayoutSpan" *and are ascents and descents of the highlight itself not of the text*. (Lipton at Col. 4, lines 37-47). In further regard to Lipton, Lipton teaches

that the present invention is intended to apply to other forms of selection. The example given in Lipton includes a selection method that blocks half the height of the typography rather than the entire height. Lipton continues with the example by indicating that it should also be understood that the continuous highlighting method and system of the present invention will work for typography formed from languages other than English. (Lipton at Col. 5, lines 27-37). All of the figures within Lipton indicate a highlighting of the words in their entirety. (See Fig. 8). Moreover, Lipton teaches the generation of a shape from the baseline entry. Accordingly, neither reference teaches or otherwise suggests “in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection from the engagement, wherein determining the height of the computer-displayed handwritten text selection from the engagement includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection,” in combination with “after the automatic determination of the height of the computer-displayed handwritten text selection, setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection” further in combination with “after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed handwritten text selection.” Reconsideration is respectfully requested.

Furthermore, independent claim 51 has been further amended to clarify the combination of “after the setting of the height of the cursor to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed handwritten text selection,” “after disengaging the highlight input, engaging the electronic pen with a computer-displayed object

other than the computer-displayed handwritten text selection”, “in response to engaging the electronic pen with the computer-displayed object, automatically discarding the determined height and determining the height of the computer-displayed object from the engagement”, “after the automatic determination of the height of the computer-displayed object, setting the electronic ink height of the electronic pen to the determined height” in combination with “after the setting of the electronic ink height of the electronic pen to the determined height, receiving a highlight input via the electronic pen, wherein the highlight input causes the distribution of the electronic ink at the determined height onto the computer-displayed object.” Applicants can find no teaching or suggestion in any of the references of the above combination of features.

Accordingly reconsideration is respectfully requested.

With regard to the dependent claims, the dependent claims include features that are not taught or otherwise suggested by the cited references. Furthermore, those claims ultimately depend from the independent claims set forth above. As such, they should be found allowable for at least those same reasons.

III. Request for Reconsideration

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

U.S. Patent Application Serial No. 10/804,616
Amendment dated June 25, 2009
Reply to Office Action of April 27, 2009

Respectfully submitted,

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